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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,211	11/16/2001	Peter M. Bonutti	BON-2950-2	7013

7590

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No.
09/992,211Applicant(s)
Bonutti et al.Examiner
Michael ThalerArt Unit
3731**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-62, 64-73, and 75-79 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64, 72, 73, 75, 78, and 79 is/are allowed.
- 6) ☒ Claim(s) 57-62, 66-71, 76, and 77 is/are rejected.
- 7) ☒ Claim(s) 65 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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The disclosure is objected to because of the following informalities: In claim 72, line 7 and claim 73, line 7, "leave" should be "have". In claim 57, line 2, and claim 64, line 2, "leaving" should be "having". In claim 77, line 12, "oral" should be "oval". Appropriate correction is required.

Claim 76 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 76 depends from cancelled claim 74.

Claims 57-62 and 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,295,994). Bonutti, in figure 14, shows an expandable cannula 162 comprising a tubular sheath which is expandable and which has an oval cross-section (col. 2, lines 24-27 and col. 10, lines 56-65) and an array of wires or filaments 172. It would have been obvious to make the expandable cannula 162 resiliently expandable since Bonutti indicates that the bladder of the invention may be formed of elastomeric material (col. 4, lines 3-8). As to claim 61, the expandable cannula 162 is inherently expandable by inserting a member therein. As to claims 62 and 71, the passage within outer wall 164 may be considered to be the claimed passage.

Claim 77 is rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al. (4,716,901). Jackson et al., in figure 4, show a cannula comprising a sheath 28 which is

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resiliently expandable and which has an oval cross-section. The expanded condition of the Jackson et al. sheath 28 is considered to be the condition in which it is expanded only slightly as compared to the condition shown in figure 4. In this slightly expanded condition, the sheath still has an oval cross section. The passage in the Jackson et al. sheath 28 (that is, the open space within the sheath) is inherently engagable by a member having an oval cross section. The Jackson et al. cannula has a pointed end portion 20.

Claims 64, 72, 73, 75, 78 and 79 are allowed.

Claim 65 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 76 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim 74 as it appeared prior to being canceled.

Applicant's arguments filed July 23, 2002 have been fully considered but they are not persuasive. The allegation that the Bonutti array of filaments 172 does not extend "between axially opposite end portions of the sheath" as defined in claim 57, line 10 (and similarly defined in claim 66) is not well founded. The Bonutti array of filaments 172 is clearly located between the ends of the sheath. Although each of the filaments 172 does not extend

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completely from one end of the sheath to the other end, this feature has not been claimed. Claim 77 fails to include all of the limitations of claims 73 and 66 prior to the last amendment.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht
August 2, 2002
FAX (703) 305-3590


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731